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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR  | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|-----------------------|---------------------|------------------|
| 10/630,818      | 07/29/2003  | Eric Edward Fullerton | ARC920000096US2     | 8153             |

50439 7590 03/21/2008  
DUFT BORNSSEN & FISHMAN, LLP  
1526 SPRUCE STREET  
SUITE 302  
BOULDER, CO 80302

EXAMINER

RICKMAN, HOLLY C

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1794

| MAIL DATE | DELIVERY MODE |
|-----------|---------------|
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03/21/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |   |  |
|------------------------------|--------------------------------------|---|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/630,818 | <b>Applicant(s)</b><br>FULLERTON ET AL. |  |
|                              | <b>Examiner</b><br>Holly Rickman     | <b>Art Unit</b><br>1794                 |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 January 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Reissue Applications*

1. The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414. The examiner notes that while applicant states that this reissue narrows the patent claims, and that new dependent claims are added, *applicant does not identify a single word, phrase or expression in the claims which is being amended.*

Applicant's attention is directed to MPEP 1414 which states:

Reissue oaths or declarations must contain the following:

- (A) A statement that the applicant believes the original patent to be wholly or partly inoperative or invalid —
  - (1) by reason of a defective specification or drawing, or
  - (2) by reason of the patentee claiming more or less than patentee had the right to claim in the patent;
- (B) A statement of at least one error which is relied upon to support the reissue application, i.e., as the basis for the reissue;
- (C) A statement that all errors which are being corrected in the reissue application up to the time of filing of the oath /declaration arose without any deceptive intention on the part of the applicant; and
- (D) The information required by 37 CFR 1.63.

The reissue oath/declaration filed with this application fails to satisfy section (B) as set forth above. See MPEP 1414, part II, for further discussion of this requirement.

2. Claims 1-16 are rejected as being based upon a defective reissue oath/declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the oath/declaration is set forth in the discussion above in this Office action.

***Claim Rejections - 35 USC § 112***

3. The rejection of claims 1-5, 8-12 and 15-16 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement is withdrawn in view of Applicant's arguments.

***Claim Rejections - 35 USC § 102***

4. The rejection of claims 1, 10, and 15-16 under 35 U.S.C. 102(g) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over lost count 1 of interference 105,110 taken in view of Toigo ("Avoiding a Data Crunch", Scientific American, May 2000, pp. 58-74) is withdrawn. Applicant's arguments with respect to the teachings of Toigo are persuasive.

5. The rejection of claims 1, 10 and 15-16 under the principles of res judicata and collateral estoppel as not patentably distinct from the subject matter of count 1 of interference 105,110 taken in view of Toigo ("Avoiding a Data Crunch", Scientific American, May 2000, pp. 58-74). *In re Deckler*, 997 F.2d 1448 (Fed. Cir. 1992) is withdrawn. Applicant's arguments with respect to the teachings of Toigo are persuasive.

***Response to Arguments***

6. Applicant's arguments filed 1/18/08 have been fully considered but they are not persuasive with respect to the reissue oath/declaration.

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Applicant argues that the reissue oath/declaration properly points to the error which is the basis for the reissue. However, the statement of at least one error which is relied upon to support the reissue application must identify a single word, phrase or expression in the claims which is being amended. Applicant's oath/declaration fails to satisfy this requirement.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Holly Rickman whose telephone number is (571) 272-1514. The examiner can normally be reached on Monday-Friday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Holly Rickman/  
Primary Examiner, Art Unit 1794